



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2016560
of 16 December 2022

Opponent: **WeWork Companies LLC Delaware company**
West 18th Street 115
10011 New York
United States of America

Representative: **Fencer BV**
Esplanade 1 box 5
1020 Brussel
Belgium

Invoked trademark: **European Union trademark registration 012076824**

WEWORK

against

Defendant: **BOUYGUES CONSTRUCTION, Société de droit français**
Avenue Eugène Freyssinet 1
78280 Guyancourt
France

Representative: **Simont Braun cvba**
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1050 Brussel
Belgium

Contested sign: **International trademark application 1553990**

WeWood

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 19 June 2020, the defendant filed an international trademark registration designating the Benelux for the wordmark WeWood for services in the classes 35, 37, 41 and 42. This application was processed under the number 1553990 and was published on 8 October 2020.

2. On 7 December 2020, the opponent filed an opposition against the registration of the application. The opposition is based on the European Union registration 012076824 of the wordmark WEWORK, filed 20 August 2013 and registered on 15 January 2014 for goods and services in classes 9, 16, 35, 36, 38, 41, 42, 43 and 45.

3. According to the register the opponent is the actual holder of the wordmark invoked.

4. The opposition is directed against all services covered by the contested application and is based on all goods and services covered by the trademark invoked. For reasons of procedural economy, opponent relied in its arguments only on some of the services in classes 35, 37, 41 and 42 for which the trademark WEWORK is registered.

5. The grounds for opposition are those laid down in article 2.14, (2)(a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 8 December 2020. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was submitted by the opponent. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 22 February 2022.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

8. The opponent filed his opposition at the Office under article 2.14, (2)(a) BCIP, in accordance with the provisions of article 2.2ter, (1)(b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and of the goods or services concerned.

A. Opponent's arguments

9. The opponent explains that WeWork is the pioneer and undisputed leader in the space-as-a-service and coworking industry in the European Union (including the Benelux) and globally. By making real estate flexible, it realized that it could exponentially increase the demand for shared office spaces, especially in urban areas. Rapidly growing since its founding in 2010, WeWork has become one of the most well-known global start-up companies and is a leader in the coworking and shared office space industry.

10. According to opponent, the defendant is a French construction company which designs, builds and operates projects in the sectors of building, infrastructure and industry. According to an online article the defendant wants to (1) reduce carbon emissions by deploying wood wherever possible; (2) use wood as an acceleration vector to build differently; (3) promote a unique experience for customers, employees and residents and (4) join the timber construction industry on a long-term basis.

11. Opponent argues that the relevant public of the services concerned, namely real estate or construction services, is composed of professionals and consumers who show a higher level of attention. According to opponent, this does not mean, however, that the minor differences between the trademarks at issue will be enough to exclude the likelihood of confusion.

12. With regard to the comparison of the services opponent states that it is clear that the services in class 35 for which the application is applied are identical to services in class 35 for which the earlier trademark is registered. In addition opponent explains that the services in class 37 for which the contested sign is applied are similar to a high degree to services in class 37 for which the trademark invoked is registered. The services in classes 41 and 42 of the contested sign are identical because they fall within the broader description of the services in classes 41 and 42 of the earlier trademark.

13. According to opponent the pronunciation of the signs is almost identical. Both sign consist of 2 syllables of which the first is identical and the second is similar, starting with the same two out of four letters. The difference in only the two final letters, will almost go unnoticed. The signs are visually also similar to a high degree. The signs are both composed of 6 letters of which 4 of them are identical and placed in the exact same order. None of the marks, taken as a whole, have any immediate meaning for the average Benelux consumer. At most, the average consumer will understand both signs as something that "we" ("wij" in Dutch and "nous" in French) do. Therefore, the conceptual comparison would not influence the overall assessment of similarity, or – for the part of the Benelux that understands English – only enhance the overall similarity. The overall similarity is high.

14. Overall, the earlier trademark WEWORK has no specific meaning likely to objectively and directly describe the services involved. As such, the distinctive character of that mark is inherently normal, even above average. Moreover, thanks to immense popularity and reputation on the market, the trademark already enjoys a higher degree of distinctiveness and thus a wider scope of protection. In support of this, opponent submits several pieces of evidence.

15. As a result of the foregoing, there is a real likelihood of confusion between the signs. According to opponent it is indeed conceivable that the average consumer, like a start-up, believes that WEWORK offers all consulting, business and real estate services, whereas the actual construction is taken care of by WeWood, but that both companies are part of the same group and therefore affiliated.

16. The opponent requests that the opposition division refuses the registration of the mark applied for in its entirety and orders the defendant to bear all costs.

17. On the request of defendant opponent filed proof of genuine use in the Benelux of the trademark invoked.

B. Defendant's arguments

18. Defendant starts by explaining that WeWood is an international leader in sustainable construction. With 58.000 responsible and committed employees in more than 60 countries, it designs, builds and operates projects in the sectors of building, civil works and energies. With more than 150 buildings built in

wood in recent years, companies of defendant and its subsidiaries, located in France and Europe, have taken upon themselves to speed up the emergence of wood projects calling this initiatives the "WeWood" approach.

19. The opponent presents itself as a provider of co-working spaces and office rental services for established companies and scaling start-ups.

20. Considering the specialized nature of the services involved, the relevant public is according to defendant made up of professionals with a high level of attention. Even if it were to be assumed that the audience consists partly of average consumers, this part of the audience would also have a higher than average level of attention.

21. Phonetically the signs in dispute consist of two syllables, one of which is common ('we') and the other different ('work'/'wood'). The signs are therefore not identical. In the second syllable the letter 'o' in both signs will not be pronounced in the same way: this letter will be pronounced in a short way in the earlier trademark and in a long way in the trademark applied for. Aurally, the ending of the signs is also very different. The signs are therefore not phonetically similar, or only to a very low and limited degree.

22. Visually it should be pointed out that in relatively short word signs, the elements at the beginning and end of the sign are as important as the central elements. It follows from case-law that the relevant public will not disregard any letter of such sign. In the present case, the last two letters of the signs are very different ('rk' and 'od'). Since they have very different endings, the signs have only a limited degree of visual similarity.

23. With regard to the conceptual comparison defendant argues that the signs are made up of a pronoun ('we') that refers to a verb ('work') or a noun ('wood'), which defines the global meaning of each mark and determines its semantic scope. The words 'work' and 'wood' are part of the basic English vocabulary, that the Benelux consumer knows and masters. 'Work' refers to a remunerated activity and 'wood' to a natural material of vegetal origin. It is thus incorrect for the opponent to claim that the signs would have no meaning for the Benelux consumer. As a whole the signs refer to different concepts and there is a significant semantic gap between them: WEWORK will be understood as 'wij werken' or 'nous travaillons', whereas 'WeWood' will be understood as 'wij het hout' or 'nous le bois'. The signs are not conceptually similar. According to defendant the sign WEWORK has a clear and specific meaning that can be grasped immediately by the Benelux public. The meaning of WEWORK differs from the conceptual semantic content of the sign WeWood. The signs thus have a different overall impression despite the existence between them of limited elements of visual and aural similarities. With reference to the Equivalenza and Picasso/Picaro judgment defendant argues that the Office may dispense the global assessment of likelihood of confusion.

24. Defendant explains extensively that there is no similarity or a very limited degree of similarity between the products and services in dispute.

25. Furthermore, defendant argues that WEWORK and the common element WE have a weak distinctive character. According to defendant the lack of distinctive character of the common element WE is confirmed by the many EU trademark registrations beginning with the pronoun WE specifically for the building sector/ services in classes 36 and 37. WE will not be perceived as an indication of any particular commercial origin. Therefore, the other elements (WORK and Wood) will prevail in the overall impression.

26. Considering all the above, defendant concludes that there cannot be any likelihood of confusion. Defendant requests the Office that the opposition will be rejected and that opponent will be ordered to bear the costs.

27. Regarding the provided materials substantiating genuine use of the trademark invoked, defendant argues that the provided proof only concerns services in relation to rental of co-working spaces in class 36 and certain ancillary services in class 35. For other goods and services for which the trademark is registered, no proof of use is provided.

III. DECISION

A. Likelihood of confusion

28. In accordance with article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

29. Article 2.2ter (1) BCIP stipulates insofar as relevant that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*¹

30. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.²

31. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.³

Comparison of the signs

32. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁴

¹ Art. 2.2ter (1)(b) BCIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

33. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁵ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁶

34. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

35. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
WEWORK	WeWood

Conceptual comparison

36. Although the average consumer normally perceives a trademark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a verbal sign, the consumer will break it down into elements which suggest a concrete meaning or which resemble words known.⁷ According to the Office the consumer will break down the trademark WEWORK in the elements 'WE' and 'WORK', because 'we' and 'work' are basic English words which are known to the Benelux consumer and the combination of the words 'we work' has a concrete meaning. In the opinion of the Office the Benelux consumer will also break down the contested sign WeWood into elements, because 'We' and 'Wood' are also basic English words which are known to the Benelux consumer, while the separate elements are emphasized due to the use of the capital letter W for We and Wood.

37. The trademark invoked WEWORK as a whole has a clear meaning for the Benelux consumer, namely 'wij werken' or 'nous travaillons'.⁸ On the other hand, the contested sign WeWood does not have a clear meaning. The combination of the personal pronoun 'We' and the noun 'Wood' is not usual ('wij het hout' or 'nous le bois').

38. Although both signs contain the personal pronoun WE, the meaning of the signs is different. The trademark invoked refers to the concept 'work', while the contested sign refers to 'wood'.

39. Given the above the Office is of the opinion that the signs are conceptually different.

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁶ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

⁷ General Court (EU) 13 February 2007, T-256/04, ECLI:EU:T:2007:46, point 57 (Respicur).

⁸ See also BOIP 5 oktober 2021, No. 2015548, point 58 (WEWORK, WE (fig.)).

Visual comparison

40. The trademark invoked is a wordmark consisting of one word with six letters: WEWORK.
41. The contested sign is also a wordmark consisting of one word with six letters: WeWood.
42. Although, in principle, a consumer will attach more importance to the first part of a sign, in this case the second part of the signs is dominant since the consumer will understand the first part of the signs as a personal pronoun ('we') and the second part as an element (verb/noun) that provides context ('work' and 'wood').
43. The first part of the signs, We, is identical. The second part of the signs, WORK versus Wood, has a different overall impression, although the first two letters are the same. Taking into account that the signs are relatively short and the second part of the signs is dominant, the consumer will certainly remark the significant difference in the endings of the signs.
44. Based on the above the Office finds that the signs are visually similar to a low degree.

Phonetic comparison

45. The trademark invoked consists of two syllables (WE-WORK). The contested sign also consists of two syllables (We-Wood). The pronunciation of the signs matches in length and rhythm. The pronunciation, however, differs in the sound of the second dominant syllables, namely WORK and Wood. This difference is significant taking into account that the signs only consist of two syllables.
46. Given the above the Office is of the opinion that the signs are aurally similar to a low degree.

Conclusion

47. As the trademark relied upon has a clear and fixed meaning that the relevant public can immediately understand, the elements of visual and aural similarity are, in the opinion of the Office, neutralised.⁹ The Office therefore concludes that the overall impression of the signs is not similar.
48. Since the equality or similarity of the conflicting signs is a necessary condition for the application of Article 2.2ter (1) (b) BCIP, the opposition cannot succeed.¹⁰

B. Other factors

49. In its response to the evidence of genuine use, the defendant also made a further response to the opponent's arguments in support of the opposition. These arguments will not be considered. Rule 1.14 IR strictly regulates when parties have an opportunity to submit arguments. In view of this, the submissions of the parties made after the administrative phase was completed will also be disregarded.

C. Conclusion

50. Based on the foregoing, the Office concludes that the opposition will be rejected.

⁹ ECJ 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, points 74, 75 and 99 (Equivalenza) and ECJ 12 January 2006, C-361/04 P, ECLI:EU:C:2006:25, point 20 (Picasso/Picaro).

¹⁰ ECJ 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 60 (Equivalenza).

51. Since the opposition will be rejected it is not necessary to assess the submitted proof of use.

IV. CONSEQUENCE

52. The opposition with number 2016560 will be rejected.

53. The international application designating the Benelux with number 1553990 will be registered for all the services for which it has been applied.

54. The opponent shall pay the defendant 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 16 December 2022



Marjolein Bronneman
(*rapporteur*)

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